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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Joon Maeng
Assignee: VTEL Corporation
Title: System and Method for Generating Invisible Notes on a Presenter's Screen
Serial No.: 09/627,731 Filing Date: July 28, 2000
Examiner: Nhon D. Nguyen Group Art Unit: 2174
Docket No.: M8307 Customer No. 33438

Austin, Texas
March 29, 2004

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APPEAL BRIEF UNDER 37 CFR § 1.191

Dear Sir:

Applicants submit this Appeal Brief pursuant to the Notice of Appeal filed in this case on January 14, 2004.

A check in the amount of \$165.00 is enclosed for this Appeal Brief. Applicants respectfully petition for a one (1) month extension of time within which to file their appeal brief, such extension allowing the undersigned until April 14, 2004 to respond. The Commissioner is hereby authorized to deduct from Deposit Account No. 502264 any other amounts required for this appeal brief and to credit any amounts overpaid to Deposit Account, No. 502264. This paper is submitted in triplicate.

I. REAL PARTY IN INTEREST

The real party in interest is the assignee, VTEL Corporation, as named in the caption above and also known as Forgent Networks Incorporated.

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II. RELATED APPEALS AND INTERFERENCES

Based on information and belief, there are no appeals or interferences that could directly affect or be directly affected by or have a bearing on the decision by the Board of Patent Appeals in the pending appeal.

III. STATUS OF CLAIMS

Claims 1 – 26 are pending in the application. Claims 1 – 26 stand rejected. Claims 1 – 26 are appealed. Appendix A contains the full set of pending claims.

IV. STATUS OF AMENDMENTS

No amendments have been filed subsequent to final rejection.

V. SUMMARY OF THE INVENTION

Plural networked workstations communicating through a network simultaneously view a target file, such as a presentation communicated in support of a video conference (page 4, line 5-11 and 23-24). One or more of the users views additional information as an overly to the target file, such as annotations or notes relating to the target file that are visible over the target file (page 5, lines 15-20). Thus, a speaker performing a presentation to remote participants during a video conference has both the presentation and annotations in view while other participants view only the presentation. An overlay junction replaces pixel values according to the overlay content so that the overlay appears over the target file (page 7, lines 20-27).

VI. ISSUES

Are claims 1, 11, 19 and 25 allowable as novel over U.S. Patent No. 6,343,314 issued to Ludwig et al?

VII. GROUPING OF THE CLAIMS

Claims 2 – 10 stand or fall with Claim 1. Claims 12 - 18 stand or fall with Claim 11. Claims 20 – 24 stand or fall with Claim 19. Claim 26 stands or falls with Claim 25.

VIII. ARGUMENTS

Independent Claims 1, 11, 19 and 25 stand rejected under 35 U.S.C. § 102 (e) as anticipated by U.S. Patent No. 6,343,314 issued to Ludwig et al.

Ludwig discloses creation by an expert of a graphical image 220 that is displayed with annotations performed by the expert or any other participant with a drawing tool 221 (Figure 41, column 36, line 61-66). Each of Applicant's Claims 1, 11, 19 and 25 recite an "overlay" viewable by some but not other viewers or users.

Applicant respectfully submits that Ludwig fails to teach, suggest or disclose an "overlay" as recited by Claims 1, 11, 19 and 25. The Examiner's rejection appears to be based upon the image 221 depicted in Figure 37, which covers over to make unviewable the image 210 of Figure 36 (See Office Action dated July 15, 2003, page 2). The Examiner maintains the rejection by construing the term "overlay" as disclosed by a file that makes unviewable a file beneath the overlay. The Examiner comments that the "invention is about 'transparent overlay' while the claimed language is only about 'overlay'" with the two terms having different implications." (*Id.* at 10; *see also* Advisory Action dated January 26, 2004 at page 2).

Applicant respectfully submits that the term "overlay" is clearly defined in Applicant's written description to preclude the Examiner's suggested construction:

The annotation file may be displayed as an overlay to the target file, so that the leader can view both the target file, as seen by all users and the annotation file, which is only seen by the leader. (pg. 2, lines 31-33)

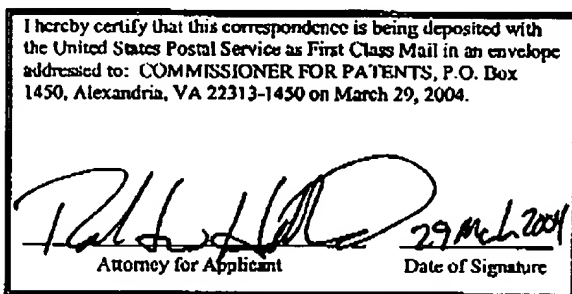
The written description describes an overlay junction 50, which displays the overlay by replacing pixel values according the annotation file (page 7, lines 20-27). The Examiner's suggested

construction of the term overlay directly contradicts Applicant's written description and would defeat the very purpose of Applicant's invention by preventing a user from viewing the user's annotations over the user's presentation. Ludwig fails to teach, suggest or disclose any display in which the image 220 is visible through the image 221 and therefore fails to teach, disclose or suggest the recited "overlay." Accordingly, Applicant respectfully submits that Claims 1, 11, 19 and 25 are allowable, as are claims 2-10, 12-18, 20-24 and 26 which depend respectively from Claims 1, 11, 19 and 25.


IX. CONCLUSION

For the above reasons, Applicants respectfully submit that rejections of pending Claims 1 – 26 are unfounded and respectfully requests that the rejection of Claims 1 – 26 be reversed.

This paper is submitted in triplicate.



Respectfully submitted,



Robert W. Holland
Attorney for Applicants
Reg. No. 40,020

APPENDIX

1. A Method of displaying an electronic file to a primary user having a primary workstation, said primary workstation coupled to a global computer network, and at least one secondary viewer at a remote location, comprising:

accessing a first file and displaying said first file on said primary workstation;
displaying said first file at said remote location on a secondary workstation, said
secondary workstation coupled to said global computer network;
accessing a second file, said second file comprising information relating to said first file;
and
displaying said second file only on said primary workstation as an overlay to said first
file, wherein said second file is not viewable by said at least one secondary
viewer.

2. The method of claim 1, wherein said second file comprises annotations to said
first file.

3. The method of claim 2, wherein displaying further comprises displaying said first
file on plural secondary workstations and wherein said second file is displayed as an overlay to
said first file on selected but not all of said plural secondary workstations.

4. The method of claim 1, wherein said first file and said second file are stored in a
server computer.

5. The method of claim 4, wherein said first file and second file are a single file, and
further wherein said second file contains a code to indicate that said second file is not for display
at said secondary workstation.

6. The method of claim 3, wherein said primary workstation comprises a plurality of
memory units, and wherein said first file is stored in a first memory unit and said second file is
stored in a second memory unit.

7. The method of claim 6, wherein said second file is overlaid over said first file using means for coupling said first file and said second file.

8. The method of claim 7, wherein said global computer network comprises a videoconferencing system.

9. The method of claim 3, wherein said primary user comprises a customer service representative and said secondary viewer comprises a customer, and said global computer network comprises the Internet.

10. The method of claim 1, further comprising activating said first file for editing by said at least one secondary viewer.

11. A method of synchronous collaboration between a plurality of remote users, each of said plurality of remote users having a user workstation, each of said user workstations being interconnected via a network of interconnected computers, wherein a first one of said plurality of remote users is a host, comprising:

accessing a file for said collaboration, said file having a first and second states, in which data stored in said first state is displayed to all of said plurality of remote users, and in which data stored in said second state is displayed only to said host as an overlay to said first state;

displaying said file on said plurality of user workstations, wherein said data stored in said second state is only displayed to said host, and wherein said data stored in said first state is displayed to said host and to said plurality of remote users; and enabling at least one of said plurality of remote users to edit said data stored in said first state.

12. The method of claim 11, wherein said network comprises a videoconference system.

13. The method of claim 11, wherein said file is stored in a location remote to any of said plurality of remote users.

14. The method of claim 13, wherein said file comprises a first file and a second file, wherein said first file comprises said data stored in said first state, and said second file comprises said data stored in said second state.

15. The method of claim 14, wherein said first file and said second file are stored in separate memory units.

16. The method of claim 15, further comprising a plurality of third files, each of said plurality of third files comprising a personal file of one of said plurality of remote users.

17. The method of claim 16, further comprising means for overlaying each of said plurality of said third files over said first file on respective ones of said user workstations.

18. The method of claim 17, further comprising a common annotation file, said common annotation file relating to said first file and accessible by more than one of said plurality of remote users.

19. A system for videoconferencing, comprising:
a first workstation having at least a first and second memory unit, said first memory unit adapted to store a first file, said second memory unit adapted to store a second file, said second file comprising information relating to said first file;
at least one video display located remote to said first workstation, said at least one video display interconnected to said first workstation and
said first workstation containing programmed instructions to cause the first file to be displayed on both the first workstation and the at least one video display, and to cause the second file to be displayed only on the first workstation as an overlay to said first file.

20. The system of claim 19, wherein said first and second memory units comprise VGA memories.

21. The system of claim 20, wherein said second file comprises an annotation of said

first file.

22. The system of claim 21, wherein said first workstation further comprises coupling means to permit said first file and said second file to be displayed on said first workstation.

23. The system of claim 20, wherein said second file is displayed as an overlay to said first file on said first workstation and selected of the video displays but less than all of the video displays.

24. The system of claim 19, wherein said second file contains a code which correlates said second file to said first file.

25. A machine readable storage medium comprising a set of instructions executable by a computer system to implement a method, the method comprising:
accessing a first file and displaying said first file on a primary workstation;
displaying said first file on a secondary workstation, said secondary workstation coupled to said primary workstation and located remotely to said primary workstation;
accessing a second file, said second file comprising annotations to said first file; and
displaying said second file only on said primary workstation, wherein said second file is not viewable on said secondary workstation.

26. The machine-readable storage medium of claim 25, wherein the machine-readable storage medium includes any of magnetic storage medium, including disk and tape storage medium, optical storage medium, including compact disk memory and digital video disk storage medium; nonvolatile memory storage memory; volatile storage medium; and modulated, electronic signals.

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